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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,531	08/26/2003	Peter Timothy Gibb	090128-0305379	2267

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EXAMINER	
MCAVOY, ELLEN M	

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/647,531	GIBB ET AL.	
	Examiner	Art Unit	
	Ellen M. McAvoy	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17 and 19-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *25* is/are allowed.

6)☒ Claim(s) *1-17,19-24 and 26-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-17, 19-24 and 26-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takigawa et al (6,251,300).

Applicants' arguments filed 28 February 2006 have been fully considered but they are not persuasive. As previously set forth, Takigawa et al ["Takigawa"] disclose a refrigerator oil coomposition for use with an HFC refrigerant which comprises (A) 70 to 99% by weight of an alkylbenzene oil containing at least 60% by weight, based on the total weight of component (A), of alkylbenzenes having a molecular weight of 200 to 350, and (B) 30 to 1% by weight of at least one synthetic oil containing oxygen including polyol esters. See column 2, lines 20-60. The alkylbenzene oil has a kinematic viscosity of 3 to 50 mm^2/s. See column 5, lines 12-18. The polyol ester may be prepared from the polyalcohols trimethylolpropane and pentaerythritol and a fatty acid having 6 to 20 carbon atoms. See column 6, lines 11-53. Takigawa teaches that the refrigerator oil may comprise only components (A) and (B) without any additives. Alternatively, conventional refrigerant additives including phosphorus compounds may be added to the oil composition. See column 10, lines 3-19. Properties in the dependent claims not taught by Takigawa, such as pour point and acid number of the alkylbenzene component, are seen to be inherent since the alkylbenzene component may be the same. Takigawa also teaches that since

the refrigerator oil composition is excellent in electrical properties and low in hygroscopy, it may be used in other applications including air conditioners and compressors of a centrifugal type. See column 14, lines 11-25.

In the response filed 28 February, independent claim 1 was amended to include that "wherein the alkyl benzene component has a molecular distribution in which at least 40% of the molecular weight fraction is greater than 350". Applicants argued that this distinguishes over the applied prior art since Takigawa teaches that "it is permissible for the alkyl benzene oil ...to contain less than 40% by weight...of alkyl benzenes having a molecular weight of less than 200 or more than 350." Applicants argue that for at least this reason, Takigawa does not teach or suggest the present invention. This is not deemed to be persuasive since "at least 40%" of the claims is seen to be indistinguishable from "less than 40%" of Takigawa. As set forth in MPEP 2144.05, in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (The prior art taught carbon monoxide concentrations of "about 1-5%" while the claim was limited to "more than 5%." The court held that "about 1-5%" allowed for concentrations slightly above 5% thus the ranges overlapped.) Here, the examiner is of the position that slightly less than 40% (39.9%) is obvious over at least 40% of the claims. It has also been held that a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Allowable Subject Matter

Claim 25, which is drawn to a lubricant composition wherein the alkyl benzene has a molecular dristribution in which at least 50% of the molecular weight fraction is greater than 350, is allowed over the prior art references of record.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
May 5, 2006